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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:
Frederick Eldin Niemi

Serial No.: 10/021,364
Issued Pat. No.: 6,925,483

Filed: December 12, 2001

For: SYSTEM FOR CHARACTERIZING INFORMATION FROM AN INFORMATION PRODUCER

Examiner: William M. Cuchlinski, Jr.

Art Unit: 2144

Confirmation No.: 9644

Cesari and McKenna, LLP
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April 6, 2010

CERTIFICATE OF TRANSMISSION

I hereby certify that the following paper(s) is/are being electronically transmitted to the Patent and Trademark Office by EFS-Web on April 6, 2010.

/Elaine Cruz/
Elaine Cruz

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO ACCEPT PRIORITY CLAIM UNDER 37 C.F.R. §1.78(a)(3) AND PETITION TO ISSUE A CERTIFICATE OF CORRECTION UNDER MPEP 1481.03(II)(B)(c)

The Director is hereby petitioned under 37 C.F.R §1.78(a)(3) to accept an unintentionally delayed claim of priority under 35 U.S.C. §120 in U.S. Patent No. 6,925,483 to additionally include the benefit of U.S. Patent No. 6,144,987, a prior-filed "parent" application in a chain of copending Continuation applications. The Director is also hereby petitioned under MPEP 1481.03(II)(B)(c) to issue a Certificate of Correction filed herewith to supply the associated explicit reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2).

Legal Basis

Patent Owner respectfully submits that the following laws, rules, and MPEP provisions provide the Director with the proper legal basis to grant the Petitions herein.

Specifically, to accept the unintentionally delayed claim of priority under 35 U.S.C. §120 to include the benefit of U.S. Patent No. 6,144,987, the relevant portions of the following laws, rules, and MPEP provisions apply:

1.) 35 U.S.C. §120:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, … which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

2.) 35 U.S.C. §255:

> Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

3.) 37 C.F.R. §1.78(a)(1):

> (1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:
>
> (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
>
> (ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.

4.) 37 C.F.R. §1.78(a)(2):

> (i) … any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. …
>
> (ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35

U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. … These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. …

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

5.) 37 C.F.R. §1.78(a)(3):

If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

6.) 37 C.F.R. §1.323:

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). …

7.) See: MPEP 201.11(III)(A):

...[I]f the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications. For

example, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---.["]

8.) See also: MPEP 201.11(III)(C):

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. See Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) and Hovlid v. Asari, 305 F. 2d 747, 134 USPQ 162 (9th Cir. 1962). The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

…Therefore, a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t) will be required if the intermediate application and the relationship of each nonprovisional application are not indicated within the period set forth in 37 CFR 1.78(a).

9.) MPEP 1481.03 (II) (B) (c)

MPEP 1481.03 (II) (B) (c) states, in part:

"Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).
Where priority is based upon 35 U.S.C. 120 to a national application, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and

(C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).
. . .

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application, for benefit claims under 35 U.S.C. 120 and 365(c).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 - § 1460) may be appropriate to pursue the desired correction of the patent for benefit claims under 35 U.S.C. 120 and 365(c)."

Facts

Patent Owner respectfully presents the following relevant facts to the Director. For ease of discussion here, Patent Owner's patent applications are referenced as follows:

"PARENT" = Application Ser. No. 09/104,558, now U.S. Patent No. 6,144,987;

"CHILD" = Application Ser. No. 09/660,689, now U.S. Patent No. 6,381,630; and

"GRANDCHILD" = Application Ser. No. 10/021,364, now U.S. Patent No. 6,925,483 (the patent which is sought to be corrected by these Petitions).

The facts regarding the above applications within the USPTO are as follows:

June 25, 1998:	PARENT is FILED, along with a Declaration signed by the inventors.
September 13, 2000:	CHILD is FILED as a continuation of PARENT. A Utility Patent Application Transmittal indicates that CHILD is a continuation of and claims priority to PARENT. CHILD uses a copy of the Declaration from PARENT under 37 C.F.R. §1.63(d).
September 19, 2000:	CHILD receives a (Second) Preliminary Amendment to include a reference to PARENT in its Specification.
November 7, 2000:	PARENT ISSUES.
December 12, 2001:	GRANDCHILD is FILED as a continuation of CHILD, which is a continuation of PARENT. A Utility Patent Application Transmittal indicates that GRANDCHILD is a continuation of and claims priority to CHILD. GRANDCHILD also uses a copy of the Declaration from CHILD under 37 C.F.R. §1.63(d), which was the Declaration originally filed in PARENT.
April 30, 2002:	CHILD ISSUES. Section (63) of the face of the patent in CHILD indicates that it is a continuation of PARENT.
August 24, 2004:	GRANDCHILD receives an Amendment, in response to a first Office Action, to include a reference to CHILD in its Specification, though unintentionally omitting a reference to PARENT. GRANDCHILD also receives a Terminal Disclaimer, terminally disclaiming GRANDCHILD to CHILD, in response to a Double Patenting rejection.
August 2, 2005:	GRANDCHILD ISSUES. Section (63) of the face of the patent in GRANDCHILD indicates that it is a continuation of CHILD, omitting a continuation chain priority claim to PARENT.
March, 2010:	GRANDCHILD's continuation chain discrepancy, unintentionally omitting a reference to PARENT, is noticed by Patent Owner during patent portfolio review.
April 1, 2010	This Petition to correct the Priority Claim in the first paragraph of the Application, and on the face of the Patent is filed.

Remarks

Patent Owner respectfully submits that granting this petition is proper for the following reasons.

The Certificate of Correction filed herewith corrects an unintentional omission made by Patent Owner, one that does not involve such changes in the patent as would constitute new matter or would require reexamination (or reissue). Specifically, the Certificate of Correction filed herewith supplies the explicit reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) to a prior-filed application.

Patent Owner respectfully notes that the CHILD patent (6,381,630), at Paragraph (63) on the face of the patent and in the first paragraph of its Specification, references the PARENT patent (6,144,987); and the GRANDCHILD patent (6,925,483) at Paragraph (63) and the first paragraph of its Specification references the CHILD patent 6,381,630. Unintentionally omitted is the required reference in the GRANDCHILD patent to the PARENT patent.

According to the accompanying Certificate of Correction filed herewith, the first paragraph of the Specification, "RELATED APPLICATIONS," has been amended to read as follows:

> This application is a continuation of U.S. patent application Ser. No. 09/660,689, filed on Sep. 13, 2000, now issued as U.S. Pat. No. 6,381,630, issued on Apr. 30, 2002, which is a continuation of U.S. patent application Ser. No. 09/104,558, filed on Jun. 25, 1998, now issued as U.S. Pat. No. 6,144,987, issued on Nov. 7, 2000.

Also, section (63) on the face of the patent, "Related U.S. Application Data," has been amended to read as follows:

> Continuation of application No. 09/660,689, filed on Sep. 13, 2000, now Pat. No. 6,381,630, which is a Continuation of application No. 09/104,558, filed on Jun. 25, 1998, now Pat. No. 6,144,987.

Patent Owner respectfully urges that the unintentional omission in the GRANDCHILD patent to reference to the PARENT patent occurred in good faith.

Patent Owner also respectfully urges that the claim of priority under 35 U.S.C. §120 in U.S. Patent No. 6,925,483 for the benefit of U.S. Patent No. 6,144,987 was unintentionally delayed. As set forth in the facts above, and in the pending Certificate of Correction, Patent No. 6,925,483 is a continuation of Patent No. 6,381,630, which itself is a continuation of Patent No. 6,144,987 (i.e., GRANDCHILD – CHILD – PARENT). Applicant's omission of the completed continuation chain in the priority claim was unintentional.

As noted above, it is generally required that a continuation "A" of a continuation "B" claim priority to the original application "C" from which B is a continuation. Since Patent No. 6,381,630, from which Patent No. 6,925,483 is a continuation, claims priority to Patent No. 6,144,987, then a priority reference should have been explicitly made in Patent No. 6,925,483 to Patent No. 6,144,987. Unfortunately, due to clerical error and oversight, this priority claim to completely describe the copendency of the continuation chain (i.e., GRANDCHILD – CHILD – PARENT) was not made in time. (Note also that Applicant's Attorney Docket Nos. for the PARENT, CHILD, and GRANDCHILD are "112025-0073," "-0073C1," and "-0073C2," where "C1" and "C2" indicate a continuation chain from the original application "-0073".) It was not until patent portfolio management in March 2010 did Patent Owner first notice this oversight and unintentional delay in properly claiming priority.

In addition, an accompanying statement by an attorney of record in U.S. Patent Nos. 6,925,483, 6,381,630, and 6,144,987, also registered to practice before the USPTO, has been submitted herewith indicating that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional.

Finally, under 37 C.F.R. §1.78(a)(3) and MPEP 1481.03(II)(B)(c), as noted above, three conditions are set forth that must be met by these Petitions:

(I) In accordance with 37 C.F.R. §1.78(a)(3)(i), the reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) to the prior-filed application has been made, i.e., herewith in the accompanying Certificate of Correction, pending acceptance.

(II) In accordance with 37 C.F.R. §1.78(a)(3)(ii), the surcharge set forth in 37 C.F.R. §1.17(t) has been paid herewith.

(III) In accordance with 37 C.F.R. §1.78(a)(3)(iii), an accompanying statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional has been filed herewith.

Patent Owner respectfully urges that these three (3) conditions are satisfied by the within Petitions, therefore a Certificate of Correction is proper to amend the issued patent to make reference to the prior copending applications for benefit of claims under 35 U.S.C. 120.

Relief Requested

For the reasons above, therefore, it is requested that the Director GRANT the Petitions in U.S. Patent No. 6,925,483 to:

1.) Accept the unintentionally delayed claim of priority under 35 U.S.C. §120 in U.S. Patent No. 6, 925,483 to include the benefit of U.S. Patent No. 6,144,987, thus completing the chain of priority and copendency from U.S. Patent No. 6,144,987 (PARENT), to its continuation application, now U.S. Patent No. 6,381,630 (CHILD), and then to its continuation application, now U.S. Patent No. 6,925,483 (GRANDCHILD); and

2.) Issue the Certificate of Correction filed herewith to supply the required explicit reference to the prior-filed applications, where the reference is required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2).

Please charge: (a) the Petition Fee under 37 C.F.R. 1.17 in the amount of $1,410.00; and (b) any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

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